



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/191,199	11/12/1998	PENG CHO TANG	238/130	8364

7590 01/22/2003

FOLEY & LARDNER  
3000 K STREET, N.W., SUITE 5000  
WASHINGTON, DC 20007-5109

EXAMINER
----------

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 01/22/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/191,199

Applicant(s)

TANG et al.

Examiner

Brenda Coleman

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 27, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16, 18, 19, 41, 44, 45, and 47 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 18, 19, 41, 44, 45, and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1624

### DETAILED ACTION

Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are pending in the application.

The **finality of the last office action is withdrawn** in view of the new ground of rejection applied below. Thus the after final amendment will be entered.

#### *Response to Amendment*

1. The cancellation of claims 20-37 is acknowledged.
2. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, first and second paragraph rejections of claims 1-9, 11-16 and 19-37 in the last office action, which are hereby **withdrawn**.

In view of the amendment dated December 27, 2001, the following new grounds of rejection apply:

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1624

3. Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 10-12, 21 and 41-52 of U.S. Patent No. 6,486,185. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the instant invention are embraced by the claims of U.S. '185.

4. Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/899,550. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the instant invention is embraced by the claims of U.S.S.N. 09/899,550.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/190,931. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the instant invention is embraced by the claims of U.S.S.N. 09/190,931.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1624

6. Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/076,140. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the instant invention is embraced by the claims of U.S.S.N. 10/076,140.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-9, 11-16, 18, 19, 41, 44, 45 and 47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/157,007. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds, compositions and method of use of the instant invention is embraced by the claims of U.S.S.N. 10/157,007.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. The applicants are required under 37 CFR § 1.105 to provide (iii) *Related Information*: A **current** copy of any copending applications, by any of the inventors, that relates to the claimed invention.

Art Unit: 1624

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays from 8:30 AM to 5:00 PM, on Tuesdays from 8:00 AM to 4:30 PM, on Wednesday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman  
Primary Examiner AU 1624  
January 17, 2003